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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/418,237	10/14/1999	JOHN H. MACKAY	3996.004/DHE	8645

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EXAMINER

PURVIS, SUE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 02/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/418,237

Applicant(s)

MACKAY ET AL.

Examiner

Sue A Purvis

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 6.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1734

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, drawn to breathable polypropylene/filler film, classified in class 428, subclass 312.2.
  - II. Claims 9-15, drawn to method of making microporous breathable film, classified in class 156, subclass 229.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the breathable polypropylene/filler film could have been made by several materially different processes such as by blow molding, casting or cast melt embossing as disclosed in the Applicant's specification (p. 9, lines 10-12).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Douglas Elliot on October 24, 2001 a provisional election was made with traverse to prosecute the invention of Group II, claims 9-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-8 are

Art Unit: 1734

withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 9, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by

Sugimoto et al. (US Patent No. 4,472,328).

Sugimoto et al. discloses a process for producing a porous film or sheet. The film is formed by combining: (1) a polyolefin resin, with polypropylene as a leading component; (2) a filler, such as calcium carbonate; and (3) hydrocarbon polymer elastomer, which is used to improve pliability of the film (col. 1, lines 33-38 and 61-68; col. 2, lines 1-15 and 29-39; col. 3, lines 16-35). The materials are combined to form a sheet and then stretched to create pores in the sheet (col. 4, lines 40-68). The percentage of filler in the sheet is variable from 10 to 80% as shown in Tables 1-14.

*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al. as applied to claim 9 above, and further in view of Schwarz (US Patent No. 4,116,892).

Sugimoto et al. discloses that stretching is important aspect of the process, but does not disclose stretching the sheet between grooved rollers.

Schwarz discloses a process for stretching a film using grooved roller pairs in the machine direction as seen in Figure 1 and 2. It will be appreciated that the grooved roll drawing permits multiple simultaneous draw necks which allow for further actual speed where draw tension is high. At high draw tension, the fibrillation phenomenon occurs which is highly desirable for porous films. Additionally, the grooved roll drawing permits a partial draw in multiple stages thereby further reducing the actual draw rate and increasing the production rate. And defects in the base film, i.e., gels, holes, etc. are carried through the grooved roll drawing with no interruption in the process as distinguished from drawing in conventional Godet and tenter frame drawing wherein such defects usually result in breaks and the necessity for subsequent shutdown (col. 8, lines 7-22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use grooved roller pairs as disclosed in Schwarz in the process of Sugimoto et al., because the use of grooved rollers results in less interruption in the process and allows for partial draw in multiple stages.

10. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al. as applied to claim 9 above, and further in view of McCormack (US Patent No. 5,695,868).

Sugimoto et al. discloses that the film produced by its process has many properties which are useful in many different types of articles including shrink wrapping or clothes (col. 5, lines 46-68; col. 6, lines 1-15).

McCormack discloses a film similar to the one in Sugimoto et al. which is bonded to a nonwoven web and used in creating personal absorbent articles and health care related items (col. 1, lines 12-28; col. 5, lines 40-50).

It would have been obvious to one having ordinary skill in the art at the time the invention was made that the next step in the process of Sugimoto et al. would be to bond the film to a nonwoven web and use this to create an article as disclosed in both Sugimoto et al. and McCormack, because McCormack shows that the bonding of the nonwoven web to the film is well known in the art to be the next step in creating these articles.

#### ***Information Disclosure Statement***

11. The information disclosure statement filed 29 September 2000 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication

Art Unit: 1734

or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

***Conclusion***


12. The following prior art is made of record but was not relied upon in previous rejection. It is, however, considered to be pertinent to the applicant's disclosure: Sheth et al. (US Patent No. 5,055,338) and McCormack et al (US Patent No. 5,955,187).

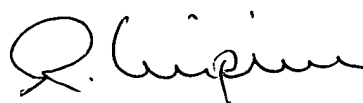
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A Purvis whose telephone number is 703-305-0507. The examiner can normally be reached on Monday, Tuesday, Thursday, and Friday 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.

sp  
January 31, 2002

  
Sue A Purvis  
Examiner  
Art Unit 1734

  
RICHARD CRISPINO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700